

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of : Attorney Docket No. 2006_1381A
Peter HEROLD et al. : Serial No. 10/593,461
Patent No. 7,868,036 :
Issued January 11, 2011 :
ORGANIC COMPOUNDS :

PETITION REGARDING PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.705(d), Patentees respectfully request reconsideration of the patent term adjustment of 250 days as set forth on the Issue Notification dated December 22, 2010. This Petition is being filed within two months of the date the patent issued, as required by 37 C.F.R. § 1.705(d).

I. Fee

As required by 37 C.F.R. § 1.705(d), this Petition is accompanied by the required fee of \$200.00.

II. Statement of the Facts Involved

A. Previously filed Petition

Patentees previously submitted a Petition Regarding Patent Term Adjustment under 37 C.F.R. § 1.705(b) on December 3, 2010 (submitted herewith as Attachment A). This Petition was not acted on prior to the above-identified patent being issued. Accordingly, Patentees kindly request consideration of the previously filed Petition. Additionally, for completeness, comments regarding the matter discussed in the previous Petition are also included in the present Petition.

B. Correct Patent Term Adjustment

The Issue Notification, dated December 22, 2010, indicates a Patent Term Adjustment to date of 250 days.

However, Patentees have calculated a Patent Term Adjustment to date of 169 days based on the following facts:

C. Relevant Dates

The above identified application has a 35 U.S.C. § 371 filing date of September 19, 2006.

The first Office Action, which was a Restriction Requirement, was mailed on July 29, 2008, resulting in a PTO delay of 253 days beyond the 14 months provided by 35 U.S.C. § 154(b).

A Response by Patentees was filed August 29, 2008, within the 3 months provided by 35 U.S.C. § 154(b).

A non-final Office Action was mailed December 3, 2008, within the 4 months provided by 35 U.S.C. § 154(b).

A Response by Patentees was filed May 4, 2009, resulting in an Patentee delay of 62 days beyond the 3 months provided by 35 U.S.C. § 154(b).

A final Office Action was mailed June 29, 2009, within the 4 months provided by 35 U.S.C. § 154(b).

A Response by Patentees was filed September 29, 2009, followed by an Advisory Action mailed October 21, 2009, and finally, a Request for Continued Examination was filed November 30, 2009, resulting in an Patentee delay of 62 days beyond the 3 months provided by 35 U.S.C. § 154(b).

A non-final Office Action was mailed March 18, 2010, within the 4 months provided by 35 U.S.C. § 154(b).

A response by Patentees was filed July 19, 2010, resulting in an Patentee delay of 31 days beyond the 3 months provided by 35 U.S.C. § 154(b).

A Notice of Allowance was mailed September 14, 2010, within the 4 months provided by 35 U.S.C. § 154(b).

The Issue Fee was paid on December 3, 2010, within the 3 months provided by 35 U.S.C. § 154(b).

The above-identified patent issued January 11, 2011, within the 4 months provided by 35 U.S.C. § 154(b).

Based upon the above information, the PTO adjustment based on delay under 35 U.S.C. § 154(b)(1)(A) is 253 days.

There were 155 days of Patentee delay under 35 U.S.C. § 154(b)(2)(C). [62+62+31]

The delay under 35 U.S.C. § 154(b)(1)(B) is 71 days, beginning September 19, 2009 (three years after the filing of the application), and ending November 29, 2009 (the day before the filing of the RCE).

The overlap, as provided for in 35 U.S.C. § 154(b)(2)(A) is 0 days.

Accordingly, the PTA set forth on the Issue Notification should be 169 days, rather than 250 days as indicated by the U.S. PTO.

The PTA tab for the above-identified patent in PAIR fails to include Patentees' Request for a New Office Action, filed April 8, 2009, as well as Patentees' response filed May 4, 2009. Additionally, the PTA tab incorrectly indicates that Patentees filed a response on December 3, 2008. These errors resulted in the incorrect PTA set forth on the Notice of Allowance and the Issue Notification. Specifically, the indication of 87 days based on the mail date of the final rejection of June 29, 2009 is incorrect. Additionally, Patentees delayed 62 days in filing the response of May 4, 2009.

Additionally, the PTA tab for the above-identified patent indicates that Patentees filed a Request for Refund on November 5, 2010, which is after the mail date of the Notice of Allowance, and accordingly indicated a Patentee delay of 68 days.

Patentees respectfully note that U.S. PTO is incorrect in this regard. The Request for Refund was transmitted to the U.S. PTO by facsimile on September 29, 2009 (submitted herewith as Attachment B), which is evidenced by the fax transmittal confirmation (submitted herewith as Attachment C). Upon receipt of the Notice of Allowance, Patentees reviewed the prosecution history for the application, and discovered that the requested refund had not been received. Thus, in accordance with the suggestion of the Office in the Clarification of 37 C.F.R. § 1.704(c)(10) (Official Gazette June 26, 2001), which states that Patentees should call the

Office instead of filing a status letter, Patentees contacted the U.S. PTO to inquire as to the status of the refund. The U.S. PTO representative indicated that a copy of the request was not received by the U.S. PTO. The U.S. PTO representative then requested that Patentees fax a courtesy copy of the earlier faxed request, together with evidence regarding the successful facsimile transmission, to the U.S. PTO. Thus, **in accordance with the request from the U.S. PTO**, Patentees **refaxed** a copy of the **earlier filed** request, for the U.S. PTO's consideration. (A copy of the documents provided to the U.S. PTO, per their request, are submitted herewith as Attachment D.)

Prior to submitting the present Petition, Patentees discussed this matter with Mr. Kerry Fries of the U.S. PTO. Mr. Fries confirmed that Patentees forwarding a courtesy copy of a previously submitted document to the U.S. PTO should **not** be considered a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

In view of the above, Patentees respectfully request that the deduction of 68 days of Patent Term Adjustment, due to the filing of a Request for Refund, be reversed.

Based upon the information provided above, Patentees respectfully request reconsideration of the PTA calculation, as set forth in the Issue Notification.

D. Terminal Disclaimer

The above-identified application is not subject to a Terminal Disclaimer.

E. Reasonable Efforts

Any Patentee delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Based upon the provisions of 37 CFR 1.705(b), and for the reasons provided in detail above, Patentees respectfully request correction of the Patent Term Adjustment to date in the above-identified application, as set forth in the Issue Notification, to 169 days.

Respectfully submitted,

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March 10, 2011

Attachments:

- (A) Copy of Petition Regarding Patent Term Adjustment Under 37 C.F.R. § 1.705(b), filed December 3, 2010
- (B) Copy of Request for Refund filed September 29, 2009
- (C) Copy of facsimile transmittal dated September 29, 2009
- (D) Copy of papers faxed November 5, 2010